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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/598,578 02/12/96 YAMASHITA

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EXAMINER

35M1/0829

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FENSTERMACHER,

ART UNIT PAPER NUMBER

3502

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DATE MAILED: 08/29/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 6/24/97 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |  |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                   |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/>  |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-20 are pending in the application.  
Of the above, claims 9-12 are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☒ Claims 13-20 are allowed.
4. ☒ Claims 1-8 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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**Part III DETAILED ACTION**

***Drawings***

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 6/28/97 have been disapproved because they introduce new matter into the drawings. 37 CFR § 1.118 states that matter involving a departure from or an addition to the original disclosure cannot be added to the application after its filing date. The original disclosure does not support the showing of the adjusting screw 52 engaging the adjusting mechanism. (Figures 1A, 1B, and new figure 1C)

***Claim Rejections - 35 USC § 112***

2. Claim 5 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is rejected as being an exact duplicate of allowable claim 13. (See MPEP 706.03(k))

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***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4 and 6-8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lumpkin (5,448,927).

Lumpkin shows an adjustable brake operating device for a bicycle comprising a base member (18) formed with a cable guide (22), the base member having a pivot point (about pin (74)) defined at a fixed position on the base member, the pivot point being spaced from the cable guide, a lever arm (14) formed with a handle portion (50) and a support portion (72), the support portion being mounted for pivotal movement about the pivot point from a brake dis-engagement position to a brake engagement position, the handle being formed with a cable connector (40), an adjusting mechanism (16) mounted in the support portion, the adjusting mechanism being spaced apart from the pivot point, the adjusting mechanism having a cable contact point (38), wherein the adjusting mechanism adjusts the relative position between the cable contact point and the pivot point; a fine adjusting mechanism (62, 64) which extends through a portion of the base

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member comprising (with regard to claim 2, there is no difference between fine adjustment when the brake lever is in the engaged or dis-engaged position) a screw (62) extending parallel to a slot (the handle fits within a slot (32)) and a pin (44), the slot confining the brake operating device.

***Response to Amendment***

5. The amendment filed 6/24/97 is objected to under 35 U.S.C. § 132 because it introduces new matter into the specification. 35 U.S.C. § 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The addition of the description of figure 1C; and the wording on page 16, line 11, which requires that figure 1C shows the adjusting screw 52 in contact with side 32.

It appears that Applicant is suggesting that an alternate embodiment discloses the structure added in the drawing amendment. This is not sufficient disclosure of the inclusion of a new figure. The Examiner disagrees with Applicant that the new features shown in the drawing submission is adequately disclosed in claim 2 and page 16 of the specification. Applicant cannot rely on an alternate species for disclosure of a patentable distinct elected species. Therefore, since claim 2 and page 16

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do not adequately disclose the drawing changes (i.e. without the consideration of the alternate embodiment), the drawing addition is held to be new matter.

In regard to the drawing changes to figures 1A and 1B, these changes are considered new matter as well. The specification discloses "However, alternatively, the adjusting screw 52 may be configured to contact one or both of the sides 31 and 32." (Page 16, lines 9-11) This is inadequate to support the changes to figures 1A and 1B. Applicant has not previously disclosed how 52 was "configured to contact" and the use of these figures (1A, 1B) to show how 52 is to be configured is new to the application.

Applicant is required to cancel the new matter in the response to this Office action.

6. Applicant's arguments with respect to claims 1-8 have been considered but are deemed to be moot in view of the new grounds of rejection.

***Allowable Subject Matter***

7. Claims 13-20 allowable over the prior art of record.

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***Facsimile Transmission***

8. Submission of your response by facsimile transmission is encouraged. Group 3500's facsimile number is **(703) 305-3597**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

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I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-3597) on \_\_\_\_\_

(Date)

Typed or printed name of person signing this certificate:

\_\_\_\_\_

\_\_\_\_\_

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

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**Conclusion**

9. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Fenstermacher whose telephone number is (703) 305-7438. The examiner can normally be reached on Monday through Friday from 9 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, can be reached on (703) 308-0830. The fax phone number for this Group is (703) 305-3597.



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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**charles.marmor@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

*Charles A. Marmor 8/28/97*  
**CHARLES A. MARMOR**  
SUPERVISORY PATENT EXAMINER  
APT UNIT 3502

*DMF 8/27/97*  
DMF  
August 27, 1997